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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|----------------------------------|----------------------|--------------------------|------------------|
| 10/626,486 90/006,093 20995 | 07/24/2003 7590 09/20/2005 | Jui-Teng Lin | SRGLT.004RA | 3794 |
| KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614 | | | EXAMINER COHEN, LEE S | |
| | | | ART UNIT 3739 | PAPER NUMBER |

DATE MAILED: 09/20/2005

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/626,486 $\frac{1}{2}$ 901006,090

Applicant(s)

LIN, JUI-TENG

Examiner

Lee S. Cohen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply**3 (THREE)**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ~~8~~ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 5/23/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Reissue/Reexamination

Applicant's arguments filed June 28, 2005 have been fully considered but they are not persuasive with respect to the 35 U.S.C. 103(a) rejection over Sher per se as detailed infra. The arguments with respect to claims 1-13, 16-21, and 23 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 14, 15, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sher. Sher discloses the basic method for presbyopia treatment at pages 34 and 35. Radial lines are cut to a depth of approximately 65 to 70% or 450 microns. Sher's method is performed by mechanical cutting. The reference fails to disclose the depth as being at 80 to 90% of the scleral thickness.

As noted by Sher at page 35, potential complications can arise from cutting too deep. Clearly, cutting to a greater depth would achieve similar results. Sher limits the depth to preclude such problems. It is also obvious to select parameters to optimize performance of a method. In re Aller 105 USPQ 233 (1955). Accordingly, cutting to 80 to 90% of the scleral depth would have been within the level of skill of the artisan to select to optimize the procedure.

As to applicant's arguments with respect to the above rejection, the Sher teaching falls short of discouraging the skilled artisan from employing a depth of 80% to 90% of the scleral

thickness. It is merely a warning that care must be taken with respect to the depth of the cut. It did not preclude greater depths as being within the scope of the disclosure. Similarly, applicant's disclosure at column 4, lines 56-58 issues a warning about the ablation depth. Further, as to the number of radial cuts, applicant's disclosure, at column 5, lines 7-9, also points out that a greater number may be employed. Accordingly, the rejection is still deemed to be proper.

Claims 1-13, 16-21, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sher in view of Schachar (5,489,299) and Lin (5,520,679). Sher discloses the basic method for presbyopia treatment as detailed supra. The reference fails to disclose the use of a laser to effect the cutting.

Schachar discloses laser correction of presbyopia by ablation of the sclera. The reference also teaches that virtually all conventional ocular lasers may be employed to effect the ablation. See pages 8-10 of the request for reexamination as well as column 7, line 53 – column 8, line 25 of the reference.

Lin discloses the particular scanning laser for corneal ablation. Figure 7A clearly shows the use of the laser to cut radial lines to predetermined depths. The request for reexamination at pages 11-15 points out the various claimed features as enumerated in the claims.

In light of the Schachar teaching, it would have been obvious to the skilled artisan to employ a laser to effect the method of Sher since the use of a laser to ablate scleral tissue is anticipated by the reference and would permit greater precision and flexibility in the carrying out the cutting procedure. Further, as taught by Schachar, the use of the conventional scanning laser of Lin could be employed to carry out the method, particularly since the cutting of radial lines is taught by the reference.

In order to ensure full consideration of any amendments, affidavits or declarations, or other documents as evidence of patentability, such documents **must** be submitted in response to this Office action. Submissions after the next Office action, which is intended to be a final action, will be governed by the requirements of 37 CFR 1.116, which will be strictly enforced.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lee S. Cohen whose telephone number is 571-272-4763. The examiner can normally be reached on Monday-Friday, 7:00-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on 571-272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Lee S. Cohen
Primary Examiner
Art Unit 3739

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September 7, 2005

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